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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
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| | | 1-771 | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on <u>May 3, 2006</u> Signature <u>Deborah Anderson</u> Typed or printed name <u>Deborah Anderson</u> | Application Number | | Filed |
| | 10/807,006 | | 03/23/2004 |
| | First Named Inventor | | |
| | Robert C. Berfield | | |
| | Art Unit | Examiner | |
| | 3632 | Alfred J. Wujciak | |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | | | |
| <input type="checkbox"/> | applicant/inventor. | | |
| <input type="checkbox"/> | assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | | |
| <input checked="" type="checkbox"/> | attorney or agent of record. Registration number <u>22,040</u> | | |
| <input type="checkbox"/> | attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | |
| | | <u>Thomas Hooker</u> Signature <u>Thomas Hooker</u> Typed or printed name <u>717-232-8771</u> Telephone number <u>May 3, 2006</u> Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Applicant's Case No.: 1-771

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert C. Berfield Examiner: Alfred J. Wujciak
Serial No: 10/807,006 Art Unit: 3632
Filed: March 23, 2004 Confirmation No.: 2819
Title: Hose Holder Customer No.: 22209

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Invention

Applicant's invention is illustrated in Figure 5. A corrugated hose includes an elastically bowed portion 56 with side sections 60 located to either side of the bowed portion. The sections are moved together and then are released between two spaced apart ribs or support members 32 forming part of holder 10. The bowed portion 56 of the hose biases the side sections 60 away from each other and against ribs 32 so that each rib is seated in a corrugation valley of a side section and the ribs hold the hose in place. The invention facilitates mounting a corrugated hose on a wall or panel. The hose can be readily removed from the holder by moving the side sections toward each other to disengage the sections from the ribs.

Final Rejection

Claims 1, 2, 5, 6, 8, 16, 17, 19, 20 and 22 are rejected under Section 103 (a) as unpatentable over Dodd in view Iversen. Claims 9 and 23 are rejected as under Section 103 (a) as unpatentable over Dodd in view of Iversen and Crouser. These rejections were initially presented in the Office Action dated July 28, 2005. Applicant's arguments that the Section 103 rejections are improper

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were presented in an Amendment filed September 21, 2005.

The final rejection contains the Examiner's supplementary arguments in support of the rejection. Applicant's supplementary arguments are presented herein.

Prior Art Relied Upon

The final rejection argues that primary reference Dodd teaches a "Corrugated hose having valleys and an elastically bowed portion." (Page 3, first paragraph). Applicant disagrees.

Dodd discloses a circa 1941 vacuum cleaner hose T which is wound around and held between four pairs of spaced, flat clamp members. A single length of the tube T is held between each pair of clamp members. See Figures 2 and 4 of Dodd.

There is no disclosure that the tube T is elastically bowed or that the tube is corrugated with valleys. The only reference to the tube T is at page 2, column 1, lines 12-16 and states the tube is flexible and is clamped between brackets.

The Examiner states that the Dodd tube "Needs to be corrugated in order to bend or weave through the brackets on the holder." The statement is false. Flexible smooth wall tubes can be bent as required and need not be corrugated to be bent. Examples are garden hoses, rubber hoses and the like. The Dodd tube need not be corrugated to be flexible.

The Examiner further argues that the plurality of lines shown on the Dodd tube T "allow the hose to be flexible with folding or bending." The lines are shown in Figure 2 but are not mentioned in the written disclosure.

Applicant submits that the lines simply indicate the curvature of the tube. There is no teaching in Dodd that these lines reflect corrugations or that they relate to folding or bending of the tube

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in any way.

The Examiner's statement that the Dodd tube is corrugated and elastically bowed is a reconstruction of Dodd made with the benefit of applicant's disclosed elastically bowed corrugated tube.

A person of ordinary skill viewing the Dodd disclosure would appreciate that the tube T is wound around the table and single portions are clamped in the holding brackets. The brackets clearly do not extend into corrugations in the tube because the brackets are flat and there are no corrugations in the tube. The brackets simply engage the flat sides of the tube.

Secondary reference Iversen is relied upon as teaching support members with ribs for retaining a corrugated hose in the member. Applicant agrees with this broad characterization of Iversen. However, Iversen uses U-shaped ribs to hold a single length of corrugated hose in place. A single length of corrugated hose is simply placed in a holder with "wings" 122 in the corrugations. The hose is held in place by gravity. See Figure 2. There is no teaching or suggestion in Iversen that an elastically bowed corrugated hose with side sections may be positioned between two spaced ribs and then released so that the elasticity of the hose holds the side sections against the ribs to support the hose.

Scope of Claims

The Examiner argues that Claims 1-23 "did [sic] not claim the portions of the tube against the outer clamp members." (Page 5)

Applicant disagrees. Independent Claim 1 provides that the side sections are "biased against the ribs by the bowed portion with each rib seated in a valley on a side section so that the ribs hold the hose in place."

Independent Claim 16 provides that "said side sections being

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biased away from each other by the bowed portion so that one valley in each side section engages one rib on each member to support the hose."

These limitations make clear that all claims are limited to a combination including a corrugated tube with an elastically bowed portion and side sections of the tube positioned between ribs where one valley of each side section engages a rib due to the elasticity in the bowed portion to support the hose. The Examiner's characterization of the claims set forth above is incorrect.

No Prima Facie Obviousness

There is no commonality between the Dodd and Iversen references, apart from the fact that each reference discloses a holder for a flexible tube. The holders are completely different.

Given the differences of Dodd and Iversen and the failure of either reference to teach using a stressed section of corrugated hose to hold side sections against ribs which support the hose, the Examiner has not established a case of prima facie obviousness and the final rejection must be withdrawn.

In the paragraph at the bottom of page 5, the Examiner argues that the suggestion to combine Dodd and Iversen is found in the fact that both Dodd and Iversen "are analogous art in vacuum and hose support." The alleged analogous relation between the references is insufficient to support a Section 103 (a) combination. A suggestion, teaching or motivation for such a combination MUST be found in the references themselves. There is none.

The Examiner improperly misinterprets Iversen as disclosing a stressed corrugated hose and then argues it would have been obvious to modify Dodd in view of misinterpreted Iversen.


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Applicant submits that the Section 103 rejection is made in hindsight with the benefit of applicant's own disclosure. This is clear because Dodd does not disclose a corrugated tube with an elastically bowed portion with side sections and Iversen only teaches placing a single length of hose in a holder having wings that extend into corrugations.

Even if the combination of Dodd in view of Iversen were made as proposed, the resulting structure would not meet applicant's claims. The Iversen U-shaped holder would replace the opposed flat brackets of Dodd located at the corners of the Dodd structure to receive a hose. This structure would not meet the claims as the hose would not be held against ribs by an elastically bowed portion.

Respectfully submitted,

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